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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,076	10/24/2001	Wenjun Luo	3COM2257-2	6227

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HAYNES BEFFEL & WOLFELD LLP
P O BOX 366
HALF MOON BAY, CA 94019

EXAMINER
CHANKONG, DOHM

ART UNIT	PAPER NUMBER
2152	

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/890,076	LUO ET AL.	
	Examiner	Art Unit	
	Dohm Chankong	2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 April 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-44* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-44* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *7/25/2001*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1> Claims 1-44 are presented for examination.

Double Patenting

2> A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3> Claims 1-21 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-20 of prior U.S. Patent No. 6.216.158. This is a double patenting rejection. Claims 1-21 of the application are substantially the same to the claims of the prior patent; the only difference being that claim 18 of the application is a limitation of claim 17 of the prior patent.

Claim Rejections - 35 USC § 102

4> The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5> Claims 22, 27, 31, 35 and 37 are rejected under 35 U.S.C § 102(e) as being unpatentable over Ortony, U.S Patent No. 6.038.595.

6> As to claim 22, Ortony discloses a data processing tool for controlling an application accessible via a network, comprising:

a console application including a user interface program, information about services, including network addresses, in a group of services accessible via the network, and a communication driver executing a protocol for communication of the console application with at least one of the services in the group [column 3 «lines 18-29, 34-48 and 56-65»];

an input/output device supporting the user interface program [column 7 «lines 2-14»]; and

a communication port by which access to the network is available [column 3 «lines 27-29»].

7> As to claim 27, Ortony discloses the data processing tool of claim 22 wherein the particular service in the group comprises an email client program [Figure 2 «item 42»].

8> As to claim 31, Ortony discloses the data processing tool of claim 22 wherein the particular service in the group comprises an internet browser service [column 5 «line 1»].

9> As to claim 35, Ortony discloses the data processing tool of claim 22, wherein the port comprises a wireless transmitter and receiver [Figure 2 «item 50»].

10> As to claim 37, Ortony discloses the data processing tool of claim 22, wherein the input/output device comprises a touch screen [column 2 «lines 43-48»].

Claim Rejections - 35 USC § 103

11> The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12> Claim 23 is rejected under 35 U.S.C § 103(a) as being unpatentable over Ortony in view of Blumenau et al, U.S Patent No. 6.438.595 ["Blumenau"].

13> Ortony does not disclose a tool wherein the protocol includes an exchange in which the console application notifies a particular service in the group of services which will act as an application host, of a set of services to be invoked.

14> Blumenau discloses an exchange in which the console application notifies a particular service in the group of services which will act as an application host, of a set of services to be invoked [Figure 2 «items 46, 49» | column 7 «lines 1-30» where: the name server is comparable to an application host as it manages the ports by which the computers in the network can access the other services]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Blumenau's application host functionality into Ortony to provide a service in the group of services that dictates access to the other services in order to monitor how many users access each service.

15> Claims 24 and 25 are rejected under 35 U.S.C § 103(a) as being unpatentable over Ortony, in view of Orenshteyn, U.S Patent No. 5.889.942.

16> As to claim 24, Ortony does not disclose a tool wherein the protocol includes an exchange by which the console application learns the network addressed of services in the group.

17> Orenshteyn discloses a tool wherein the protocol includes an exchange by which the console application learns the network addressed of services in the group [column 5 «lines 8-

15»]. It would have been obvious to one of ordinary skill in the art to implement Orenshteyn's address discovery method into Ortony's data processing tool to allow the user to dynamically discover the services provided within his local area network.

18› As to claim 25, Ortony does disclose an exchange in which a particular service sends the console application a set of instructions [column 3 «lines 56-65»] but does not specifically disclose a tool wherein the protocol includes an exchange in which a particular service in the group of services sends the console application a set of user interface constructs for incorporation in the user interface program.

19› Orenshteyn discloses a tool wherein the protocol includes an exchange in which a particular service in the group of services sends the console application a set of user interface constructs for incorporation in the user interface program [column 5 «lines 16-31»]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Orenshteyn's user interface construct commands into Ortony's server-processing tool system to allow the particular service control over what is displayed on Ortony's data processing tool.

20› Claims 26, 28-30, 32-34 and 38 are rejected under 35 U.S.C § 103(a) as being unpatentable over Ortony and Orenshteyn, in further view of an Official Notice.

21> As to claims 26, 28-30 and 32-34, Ortony discloses the use of network services for various purposes [column 5 «lines 1-2»], but does not specifically disclose all the services, as claimed. However, services such as a slide presentation, calendar program, control of appliance, print and fax services, speech translation and room reservation function are well known in the art and not patentably distinct as they are merely fields of use. Therefore, Official Notice is taken that one of ordinary skill in the art would have reasonably implemented the aforementioned services in Ortony to provide a greater range of functionality of services available to the user.

22> As to claim 38, Ortony discloses the use of a touch screen as an input/output device but does not specifically disclose the dimensions as claimed. Official Notice is taken that the dimension of a touch screen on a handheld device is a matter of preference, and one of reasonable skill in the art would have reasonably inferred that the touch screen would have to be at least a minimum size to fit on the handheld or portable device. Therefore, it would have been obvious to implement the size restrictions of 4 inches by 6 inches or smaller on the handheld device to keep the size of the device within the limits of portability.

23> Claim 36 is rejected under 35 U.S.C § 103(a) as being unpatentable over Ortony and Orenshteyn, in further view of Whitehead et al, U.S Patent No. 6.085.030 ["Whitehead"].

24> Ortony discloses a wireless link, but does not specifically disclose that it is an infrared link, or comprises an infrared transmitter and receiver.

25› Whitehead discloses a communication link comprising an infrared link, and that its use is well known in the art [column 6 «lines 20-25»]. Therefore, it would have been obvious to one of ordinary skill to have reasonably implemented Ortony's wireless link as an infrared link as taught by Whitehead, thereby increasing the number of computing platforms with which Frese's system is compatible, most notably, infrared-enabled and wireless devices.

26› Claim 39 is rejected under 35 U.S.C § 103(a) as being unpatentable over Frese, II et al, U.S Patent No. 5.909.545 ["Frese"], in view of Ortony.

27› Frese discloses a method for controlling an application executable on a particular processor coupled to a network using a computing platform, comprising:

establishing a communication link via the network between the computing platform and the particular processor [Figure 1 «items 16,20» | column 6 «lines 39-59»];

transferring a control program to the computing platform via the network, the control program including user interface constructs for generating commands for control of the application [column 4 «lines 25-32»];

transmitting commands input using the control program to the particular processor via the communication link [column 4 «lines 32-50»];

transferring the commands input using the control program to the application [column 4 «lines 32-50» | column 5 «lines 1-14»].

Frese does not explicitly disclose that the computing platform is portable.

28> Ortony discloses a method for controlling an application executable on a particular processor coupled to a network using a portable computing platform [column 4 «lines 13-31»]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have implemented Frese's computing platform as a portable computing platform to increase the functionality of his invention by allowing portable devices and wireless control of applications in his network as taught by Ortony. Frese further suggests this implementation, disclosing that other computing platforms may be used in his network [column 6 «lines 65-66»].

29> As to claim 42, Frese does not disclose a method wherein the communications link comprises a wireless link.

30> Ortony discloses a method wherein the communications link comprises a wireless link [column 4 «lines 23-31»]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have implemented Frese's computing platform as a portable computing platform to increase the functionality of his invention by allowing portable devices and wireless control of applications in his network as taught by Ortony.

31> As to claim 44, Frese does not disclose a method wherein the portable computing platform includes a touch screen, and the interface constructs include graphical interface elements accepting inputs via the touch screen.

32› Ortony discloses a method wherein the portable computing platform includes a touch screen, and the interface constructs include graphical interface elements accepting inputs via the touch screen [column 2 «lines 39-48» | column 6 «line 62» to column 7 «line 14»]. It would have been obvious to one of ordinary skill in the art to implement Ortony's portable computing platform and touch screen functionality into Frese as such it allows the user direct point and click control of the remote controlled applications.

33› Claims 40 and 41 are rejected under 35 U.S.C § 103(a) as being unpatentable over Frese and Ortony, in further view of Myers et al, "Collaboration Using Multiple PDAs connected to a PC" ["Myers"].

34› As to claim 40, Frese does disclose remote execution of computer programs over a network but does not explicitly disclose a method wherein the application comprises a slide presentation application, and the commands input using the control program include commands for opening a presentation for display on a display coupled to the network, under control of the particular processor, and navigating slides within the presentation.

35› Myers discloses a method wherein the application comprises a slide presentation application, and the commands input using the control program include commands for opening a presentation for display on a display coupled to the network, under control of the particular processor, and navigating slides within the presentation [page 6 «section titled

"PowerPoint Version"»]. It would have been obvious to one of ordinary skill in the art to have reasonably inferred and implemented a slide presentation application into Frese's remote control method as taught by Myers. One would have been motivated to perform the implementation in Frese to allow users access to existing applications such as PowerPoint.

36› As to claim 41, Frese does disclose remote execution of computer programs over a network but does not explicitly disclose a method wherein the application comprises a slide presentation application, and the commands input using the control program include commands for editing slides within the presentation.

37› Myers discloses a method wherein the application comprises a slide presentation application, and the commands input using the control program include commands for editing slides within the presentation. [page 6 «section titled "PowerPoint Version"»]. It would have been obvious to one of ordinary skill in the art to have reasonably inferred and implemented a slide presentation application into Frese's remote control method as taught by Myers. One would have been motivated to perform the implementation in Frese to allow users to control existing applications such as PowerPoint.

38› Claim 43 is rejected under 35 U.S.C § 103(a) as being unpatentable over Frese and Ortony, in further view of Whitehead.

39› Frese does not disclose a method wherein the communication link comprises an infrared link.

40› Whitehead discloses a communication link comprising an infrared link, and that its use is well known in the art [column 6 «lines 20-25»]. Therefore, it would have been obvious to one of ordinary skill to have reasonably inferred an implementation of an infrared wireless network as Frese's network, thereby increasing the number of computing platforms with which Frese's system is compatible, most notably, infrared-enabled and wireless devices.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Amro et al, U.S Patent No. 6.507.762 – [abstract – remote control of an appliance using a PDA].

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is (703)305-8864. The examiner can normally be reached on 8:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (703)305-8498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DC

ZARNI MAUNG
PRIMARY EXAMINER